

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision being entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES

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Ex parte KARL-HEINZ DOPKE, GARLICH'S SIEMEN  
and HORST RATHERT

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Appeal No. 96-0425  
Application No. 08/108,986<sup>1</sup>

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ON BRIEF

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Before McCANDLISH, Senior Administrative Patent Judge,  
ABRAMS and NASE, Administrative Patent Judges.  
NASE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's final rejection of claims 1 through 6 and 11. Claims 8 through 10, 13, 14 and 16 through 23 have been allowed. Claims 7, 12 and 15 have been canceled.

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<sup>1</sup> Application for patent filed August 18, 1993.

Appeal No. 96-0425  
Application No. 08/108,986

We REVERSE.

BACKGROUND

The appellants' invention relates to an apparatus for transporting printing works products. An understanding of the invention can be derived from a reading of exemplary claim 1, which is reproduced in the opinion section below.

The prior art reference of record relied upon by the examiner in rejecting the appealed claims is:

Hognestad et al. (Hognestad)	5,018,940	May 28,
1991		

Claims 1 through 6 and 11 stand rejected under 35 U.S.C. § 103 as being unpatentable over Hognestad.

Rather than reiterate the conflicting viewpoints advanced by the examiner and the appellants regarding the above-noted rejection, we make reference to the examiner's answer (Paper No. 14, mailed June 26, 1995) for the examiner's complete reasoning in support of the rejection, and to the appellants' brief (Paper No. 13, filed April 17, 1995) for the appellants' arguments thereagainst.

Appeal No. 96-0425  
Application No. 08/108,986

Page 4

OPINION

In reaching our decision in this appeal, we have given careful consideration to the appellants' specification and claims, to the applied prior art reference, and to the respective positions articulated by the appellants and the examiner. Upon evaluation of all the evidence before us, it is our conclusion that the evidence adduced by the examiner is insufficient to establish a prima facie case of obviousness with respect to the claims under appeal. Accordingly, we will not sustain the examiner's rejection of claims 1 through 6 and 11 under 35 U.S.C. § 103. Our reasoning for this determination follows.

In rejecting claims under 35 U.S.C. § 103, the examiner bears the initial burden of presenting a prima facie case of obviousness. See In re Rijckaert, 9 F.3d 1531, 1532, 28 USPQ2d 1955, 1956 (Fed. Cir. 1993). A prima facie case of obviousness is established by presenting evidence that the reference teachings would appear to be sufficient for one of ordinary skill in the relevant art having the references before him to make the proposed combination or other

modification. See In re Lintner, 9 F.2d 1013, 1016, 173 USPQ 560, 562 (CCPA 1972). Furthermore, the conclusion that the claimed subject matter is prima facie obvious must be supported by evidence, as shown by some objective teaching in the prior art or by knowledge generally available to one of ordinary skill in the art that would have led that individual to combine the relevant teachings of the references to arrive at the claimed invention. See In re Fine, 837 F.2d 1071, 1074, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). Rejections based on

§ 103 must rest on a factual basis with these facts being interpreted without hindsight reconstruction of the invention from the prior art. The examiner may not, because of doubt that the invention is patentable, resort to speculation, unfounded assumption or hindsight reconstruction to supply deficiencies in the factual basis for the rejection. See In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 177 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968). Our reviewing court has repeatedly cautioned against employing hindsight by using the appellants' disclosure as a blueprint to reconstruct the claimed invention from the isolated teachings of the prior

art. See, e.g., Grain Processing Corp. v. American  
Maize-Products Co., 840 F.2d 902, 907, 5 USPQ2d 1788, 1792  
(Fed. Cir. 1988).

With this as background, we turn to the examiner's  
rejection of claim 1, the only independent claim on appeal.

Claim 1 recites:

In an apparatus for transporting printing works  
products, the products comprising partially or completely  
finished books, said transporting apparatus including the  
capability of altering the arrangement of the transported  
products between generally vertically arranged stacks of  
products and individual products, the improvement  
comprising:

first conveyor means for transporting stacks of the  
said products;

second conveyor means for transporting individual of  
the said products as a serial stream of products;

means positioned intermediate said first and second  
conveyor means for supporting a stack of products, said  
supporting means including means for controlling the  
motion of the uppermost product in a stack between a  
position on a supported stack of products and a position  
on said second conveyor means;

means for adjusting the vertical relationship  
between said supporting means and the end of said second  
conveyor means which is located in closest proximity to  
said supporting means, said adjusting means causing the  
vertical position of the uppermost product of the stack

of products on said supporting means to be commensurate with the vertical portion of said end of said second conveyor means; and

means for moving a stack of products between said first conveyor means and said supporting means simultaneously with the controlled motion of the lowermost product of a stack between said supporting means and said second conveyor means.

Hognestad discloses an apparatus for separating one or more essentially thin and planar products (3), such as books, periodicals and newspapers, from a stack (2) of such products. As shown in Figure 1, the apparatus includes a gripping arrangement (6) for gripping of at least one product (3) at a time at the top of the stack (2), and for lateral movement of the product to engagement with a further-feeding transport apparatus (7), and a threshold construction (14) forming an abutment against the products (3) below the product to be separated at a time, and which has a slot opening (15) having a height (H) allowing the passing of only said at least one product at a time. The threshold construction (14) is connected to a position sensor (20) sensing the top level of the stack (2) and giving a signal to a regulator (5) and the regulator controls a stack-supporting hoisting mechanism (1),



so that the hoisting mechanism raises the stack (2) to the correct top level in relation to the threshold construction.

Hognestad teaches (column 2, lines 28-32) that

the hoisting means comprises a stack-supporting hoist table 4 which, e.g., may consist of a number of rollers so that the stack in question can be advanced to the correct position by means of a belt feeder (not shown).

Hognestad also teaches (column 5, lines 12-16) that

the apparatus may also be designed so that the stack with the products in question is stationary, whereas the gripper and the threshold means are moved downwards concurrently with the product separation.

After the scope and content of the prior art are determined, the differences between the prior art and the claims at issue are to be ascertained. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966).

Based on our analysis and review of Hognestad and claim 1, it is our opinion that the only difference is the limitation

means for moving a stack of products between said first conveyor means and said supporting means simultaneously with the controlled motion of the lowermost product of a stack between said supporting means and said second conveyor means.

With regard to this difference, the examiner determined  
(answer, p. 3) that

[i]t would have been obvious to one of ordinary skill in the art at the time the invention was made to have used a stationary first conveyor and stack and movable threshold means 14 and transport 7 which deliver separate articles to a second conveyor in the device of Hognestad et al., since the reference specifically suggests such a modification.

We agree. The examiner then went on and determined (answer, pp. 3-4) that

one of ordinary skill in the art would have readily ascertained the constructional arrangement necessary for the device to operate in the manner described in the reference, including coordination of movement of the belt feeder to provide a new stack with the removal of the last article of a previous stack.

We do not agree.

We agree with the appellants' argument (brief, pp. 7-8) that Hognestad does not teach or suggest "means for moving a stack of products between said first conveyor means and said supporting means simultaneously with the controlled motion of the lowermost product of a stack between said supporting means

and said second conveyor means" as recited in claim 1. In that regard, we agree with the appellants position that Hognestad only teaches that the steps of removing the last product from a stack and supplying a new stack of products be performed sequentially. We have reviewed the entire disclosure of Hognestad and find no suggestion therein of the claimed simultaneous movement. Accordingly, we must conclude that the examiner has resorted to speculation, unfounded assumption or hindsight reconstruction to supply the deficiencies in the factual basis for the rejection.

Furthermore, even if the position of the examiner was correct, the modified device of Hognestad would not have any structure corresponding to the claimed "means for moving." As explained in In re Donaldson, 16 F.3d 1189, 1193, 29 USPQ2d 1845, 1848-49 (Fed. Cir. 1994), the PTO is not exempt from following the statutory mandate of 35 U.S.C. § 112, paragraph 6, which reads:

An element in a claim for a combination may be expressed as a means or step for performing a specified function without the recital of structure, material, or acts in support thereof, and such claim shall be construed to

cover the corresponding structure, material, or acts described in the specification and equivalents thereof.

Per Donaldson, the "broadest reasonable interpretation" that an examiner may give means-plus-function language is that statutorily mandated in paragraph six. Accordingly, the PTO may not disregard the structure disclosed in the specification corresponding to such language when rendering a patentability determination. In this case, the claimed "means for moving" is separate from the first conveyor means (i.e., entry conveyor 2) and is construed to cover the corresponding structure described in the specification (i.e., accelerating roller 20, counter-pressure roller 21 and moveable barrier 22) and equivalents thereof. In this case, the examiner has not pointed to any structure in Hognestad that would be equivalent to this structure. In fact, it would appear to us that the examiner was relying on Hognestad's belt feeder to be both the claimed "first conveyor means" and the claimed "means for moving." This is inappropriate in this instance.

For the reasons set forth above, the decision of the examiner to reject claim 1, and claims 2 through 6 and 11 dependent thereon, under 35 U.S.C. § 103 is reversed.

CONCLUSION

To summarize, the decision of the examiner to reject  
claims 1 through 6 and 11 under 35 U.S.C. § 103 is reversed.

REVERSED

HARRISON E. McCANDLISH	)	
Senior Administrative Patent Judge	)	
)	)	
	)	
	)	
	)	BOARD OF PATENT
NEAL E. ABRAMS	)	APPEALS
Administrative Patent Judge	)	AND
	)	INTERFERENCES
	)	
	)	
	)	
JEFFREY V. NASE	)	
Administrative Patent Judge	)	

Appeal No. 96-0425  
Application No. 08/108,986

Page 15

ALIX, YALE & RISTAS, LLP  
750 MAIN STREET  
HARTFORD, CT 06103-2708

APPEAL NO. 96-0425 - JUDGE NASE  
APPLICATION NO. 08/108,986

APJ NASE

SAPJ McCANDLISH

APJ ABRAMS

DECISION: **REVERSED**

Prepared By: Gloria Henderson

**DRAFT TYPED:** 20 Jan 99

**FINAL TYPED:**